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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/587,695      | 07/27/2006  | Masaharu Akamatsu    | 59559.00033         | 8439             |

32294 7590 12/19/2007  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
14TH FLOOR  
8000 TOWERS CRESCENT  
TYSONS CORNER, VA 22182

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| EXAMINER |
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BODAWALA, DIMPLE N

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| ART UNIT | PAPER NUMBER |
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1791

|           |               |
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| MAIL DATE | DELIVERY MODE |
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12/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                |                                    |  |
|------------------------------|--------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/587,695  | Applicant(s)<br>AKAMATSU, MASAHARU |  |
|                              | Examiner<br>Dimple N. Bodawala | Art Unit<br>1791                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/27/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1-5, drawn to a press molding apparatus in the reply filed on November 16, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita et al. (U S Patent No. 5,558,015) in view of Coluzzi (U S Patent No. 5,051,083).
6. Miyashita et al. ('015) discloses a hot press apparatus as a press molding apparatus which comprises an upper bolster (7) as a first mold; a lower bolster (6) as a second mold, wherein second mold is disposed to face the first mold (7) such that the second mold can advanced and retreat by the pneumatic cylinder (14) (See figure 1 and 4). It further teaches that the mold includes the substrate (40) and heat insulating member (10a, 10b) which is disposed on a side of the substrate (40) which side faces the first mold (7) (See figure 1). It further discloses a heating processing section (11a, 11b) for heating the first mold and second mold (See figure 1), wherein the heating section (11a,11b) is disposed between the heat insulating member (10a,10b) and plate (38a, 38b) (See figure 1), wherein the heating section is involved to heat first and second mold. It further discloses a loading processing section which is involved to load the substrate of perform on the mold (See col.5 lines

30-35). It further discloses a transfer processing section for pressing the upper mold against the lower mold (See col.6 lines 18-41).

7. Miyashita et al. ('015) discloses all claimed structural limitations as discussed above, but fails to teach or suggest a machining member with irregularities.

8. In the analogous art, Coluzzi ('083) discloses a press molding apparatus which is involved to form multiple impression on the plastic plate, wherein the apparatus comprises a first mold (9), a second mold (5), a plastic plate (4) as a mold preform, an insulating plate (6), and an original plate (19) as a machining member having an engraved design (19b) as an irregularities which can be transferred to the preform (4) and involved to provide the desired pattern on the preform during the press molding operation (See figures 2 and 5; col. 5 lines 39-45).

9. Here, claims disclose some of claimed structural limitations such as a loading processing section, a heating processing section, and a transfer processing section, which are involved for an intended uses. As we know that intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*; 168 USPQ 530. the manner or method in which a machine is to be utilized is not germane to the

issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235,238.

Purpose to which apparatus is to be put and expression relating the apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Thus, it can be understandable that the prior arts disclose all claimed structural limitations with uses of them as defined in the claim of the instant application.

10. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Miyashita et al. ('015) by providing a machining member with irregularities because such an alignment is involved to imprint desired pattern on the preform during the molding operation as suggested by Coluzzi ('083).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTOL – 892 for further references related to the hot press molding machine and imprint lithography).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dimple N. Bodawala whose telephone number is (571) 272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

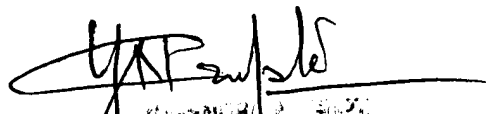
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control  
Number: 10/587,695  
Art Unit: 1791

Page 7

DNB

  
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